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**PATENT APPLICATION**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Shigeru NAKAYAMA

Group Art Unit: 2877

Application No.: 10/024,145

Examiner: H. Lee

Filed: December 21, 2001

Docket No.: 111562

For: APPARATUS FOR MEASURING SURFACE SHAPE, LATERAL COORDINATE CALIBRATION METHOD THEREFOR, AND OPTICAL MEMBER HAVING BEEN MEASURED WITH SAID APPARATUS OR METHOD

**RESPONSE TO RESTRICTION REQUIREMENT**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In reply to the January 20, 2004 Restriction Requirement, Applicant provisionally elects Group II, claims 9-16, with traverse.

In a February 17, 2004 telephone conference with the undersigned, Examiner Lee confirmed that the January 20, 2004 Restriction Requirement erroneously indicates the claim groupings for Groups I and II. In the telephone conference, Examiner Lee confirmed that Group I includes claims 1-8 and Group II includes claims 9-16.

It is respectfully submitted that the subject matter of all claims 1-16 is sufficiently related that a thorough search for the subject matter of any one Group of claims would encompass a search for the subject matter of the remaining claims. Thus, it is respectfully submitted that the search and examination of the entire application could be made without serious burden. See MPEP §803 in which it is stated that "if the search and examination of an

entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions" (emphasis added). It is respectfully submitted that this policy should apply in the present application in order to avoid unnecessary delay and expense to Applicant and duplicative examination by the Patent Office.

Thus, withdrawal of the Restriction Requirement is respectfully requested.

In addition, the Examiner is requested to consider the references submitted in the Information Disclosure Statement filed April 26, 2002. The Examiner is invited to contact Applicant's undersigned attorney at the telephone number listed below if, for some reason, the Information Disclosure Statement is not present in the Patent Office file.

Respectfully submitted,



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Date: February 19, 2004

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